

146.1309

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: : L.E. Smith
JEAN-LUC DUBOIS :
Serial No.: 09/194,996 :
Filed: December 4, 1998 :
For: TRANSDERMIC...MEDICAMENTS :

600 Third Avenue
New York N.Y. 10016
February 8, 2002

RENEWED PETITION UNDER 37 CFR 1.47(b)

Asst. Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the decision on the renewed petition dated December 14, 2001 in the above application, Applicant again renew the request for acceptance of the application in view of the declaration of Mr. Vieillefosse filed herewith.

In the discussion the legal Examiner indicated that items 1 to 4 and 6 have been satisfied. However, with respect to proof that 37 CFR 1.47(b), Applicant had sufficient proprietary interest in the application has not been satisfied. The legal Examiner stated that the statements by Mr. Vieillefosse of record are insufficient for the reasons set forth in the decision dated May 21, 2001 wherein the legal Examiner noted that it had not been demonstrated that the employee had been performing an inventive task corresponding to his actual duties or performing studies or research which he has been explicitly entrusted for the invention to belong to the employer.

Applicant believes that the declaration of Mr. Vieillefosse filed herewith taken together with all of the other declarations he has provided clearly demonstrates that Aventis Pharma has the authority to file the application on their own behalf. The declaration by Mr. Vieillefosse states unequivocally that he sat on the Patent Department of Aventis Pharma during the time that Jean-Luc Dubois was employed therein. He further states that he reviews invention disclosures submitted by the researchers of Aventis Pharma to decide if the disclosure is patentable and if so, if it is of sufficient interest to justify filing a patent application.

The declaration further states that he received the invention disclosure for the present application which was submitted by Mr. Dubois as a result of his research duties in accordance with his employment contract and that it was determined that the subject matter was patentable and of sufficient interest to justify filing a patent application. Therefore, a French priority application was filed naming Mr. Dubois as the inventor. The PCT application for the above application was timely filed designating among other countries, the United States, and it was then extended to the United States without Mr. Dubois' signature since he refused to sign the declaration and assignment when they were submitted to him to sign by Mr. Vieillefosse. Moreover, these facts are known from Mr. Vieillefosse's own first-hand knowledge that they are true and

accurate. Therefore, it is believed that the record unequivocally demonstrates that Aventis Pharma has sufficient proprietary interest in the application to justify accepting it under Rule 1.47(b).

Respectfully submitted,
Bierman, Muserlian and Lucas

By: 

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CAM:ds
Enclosures